

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Kelley et al.	Art Unit	: 2161
Serial No.	: 10/624,085	Examiner	: Charles Edward Lu
Filed	: July 21, 2003	Conf. No.	: 6000
Title	: SYSTEM AND METHOD FOR AN ADAPTIVE USER COMMUNICATIONS DEVICE		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
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REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer dated January 28, 2009 as follows:

I. Examiner's Answer Pages 40-47

In direct conflict with the requirements of MPEP §2111, the Examiner continues to rely on overly broad and arbitrary interpretations of the pending claims that are inconsistent with the specification and the express claim language. In doing so, the Examiner ignores the hardware and data structures of the claimed subject matter, as well as their arrangement.

With respect to the virtual database of claim 1, the Examiner (Examiner's Answer to Appeal Brief of January 28, 2009 at page 41) now asserts that Kramer et al. teach a consumer profile that includes "facts pertinent to the consumer" and a "consumer model." The Examiner (*Id.*) states that (emphasis added) "The claimed 'user profile' is met by Kramer's consumer profile." Further, the Examiner (*Id.* at page 42) asserts that Kramer's secure client database, which stores the consumer profile, "is a 'virtual database' that comprises the user profile, as claimed...."

However, claim 1 recites (emphasis added) "...at least one mobile communications device in communication with at least one network;...a virtual database accessible to the at least

one mobile communications device over the at least one network, wherein said virtual database comprises: a user profile including at least one actual user characteristic received over the at least one network; a heuristic modeler that generates at least one heuristic user characteristic in accordance with the at least one actual user characteristic, wherein the heuristic user characteristic is stored in the user profile;....”

The content of the virtual database aside, Kramer et al. teach that the secure client database is accessible only to the client computer and cannot be accessed over a network. For example, Kramer et al. (Col. 9, lines 14-17) teach (emphasis added) “Another difference with existing approaches to ‘personalized web pages’ is that the consumer profile is stored under the control of the consumer’s computer. This method provides an extra level of privacy protection.” Further, Kramer et al. (Col. 16, lines 31-41 and FIG. 6) disclose (emphasis added)...

The heart of the client side 600 of TIC is a secure database J. All consumer-specific persistent data of any kind including transaction data, metadata, model data, calendar data, policies, administrative information, the location of TIC servers 604, reside in and are only accessible through the database interface. Access to the database is through Java. Only TIC software has access to the database access routines and the on-disk forms of the data are encrypted with a private key under the control of the client (i.e. consumer computer).

Kramer et al. (Abstract) also disclose (emphasis added) “The consumer profiles are logically controlled by the consumer’s computer, thus providing for enhanced security over information that is personal and confidential to the consumer,....” Therefore, Kramer et al. expressly teach that the secure database J, including all consumer-specific persistent data of any kind, is accessible only to the client computer.

Further, while Kramer et al. (Col. 16, lines 43-47) suggest that the secure database J can be physically resident on other devices, Kramer et al. nonetheless do not disclose or suggest that the secure database J can be accessed by a mobile communications device over a network, as recited by claim 1. The Examiner (Examiner's Answer to Appeal Brief of January 28, 2009 at pages 42-43) appears to recognize this deficiency and instead points to Kramer et al.'s disclosure (Col. 20, lines 57-65) of the database 804 to illustrate network access. However, as discussed in the Appeal Brief filed on October 30, 2008, Kramer et al. do not disclose or suggest that the database 804 and the attribute vector 808 form the claimed user profile. Rather, Kramer et al. (Col. 21, lines 51-58) teach that the database 804 and attribute vector 808 are separate sources that are used in the alternative. Therefore, the database 804 and the separate attribute vector 808 cannot be combined to form the claimed user profile. Accordingly, Kramer et al. do not disclose, teach, or suggest a virtual database accessible to the at least one mobile communications device over the at least one network, wherein said virtual database comprises: a user profile including at least one actual user characteristic received over the at least one network; a heuristic modeler that generates at least one heuristic user characteristic in accordance with the at least one actual user characteristic, wherein the heuristic user characteristic is stored in the user profile, as recited in claim 1.

For at least these reasons, claim 1 is allowable over the proposed combination of Kramer et al. and Martin Jr. et al. Claims 2, 4, 6, 8-12, and 14-52 depend from claim 1 and therefore are allowable for at least the reasons discussed with respect to claim 1.

With respect to the at least one monitor of claim 6, the Examiner (Examiner's Answer to Appeal Brief of January 28, 2009 at page 44) asserts that Kramer et al. disclose monitoring a

user's transactions on the user's computer. Further, the Examiner (*Id.*) asserts that "Martin shows a mobile device and monitoring the time and location of the device for providing targeted advertising (col. 11, lines 49-60)." Thus, the Examiner concludes that (emphasis added) "the combination teaches or suggests monitoring the transactions, time and location of a mobile communication device, and storing the monitored information in the database for providing advertising." The Examiner (*Id.*) then further concludes (emphasis added) "Kramer/Martin monitors the customer transactions occurring during operation of the customer's device and would thus vary the stored customer characteristics according to the customer's online actions."

The Examiner's conclusions find no support in either reference. Rather, the rejection based on the proposed combination of Kramer et al. and Martin Jr. et al. amounts to nothing more than an attempt to show that each individual claimed feature was independently known in the prior art. Such lack of common sense reasoning was clearly deemed improper by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.* (*See KSR Int'l Co. v. Teleflex Inc.*, slip op. at 14-15.)

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

See, Id. at 14-15 (emphasis added).

In fact, the proposed combination of Kramer et al. and Martin Jr. et al. does not logically come together because the Examiner attempts to assemble the claimed features based only on knowledge taken from Applicants' disclosure. Such an approach is contrary to the guidance that, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account *only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.*" *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971); MPEP §2145 (X)(A). (Emphasis Added.) Further, the Supreme Court warned against improper hindsight in *KSR*. (*See KSR Int'l Co. v. Teleflex Inc.*, slip op. at 18. Emphasis added.)

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U. S., at 36 (*warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight"* (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it. (*See, id.* Emphasis added.)

In the present situation, the knowledge within the level of ordinary skill in the art would not have led to the proposed combination. Thus, the knowledge represented by the formation of the proposed combination could have been gleaned only from the Applicants' disclosure. Further, the reasoning proffered by the Examiner defies common sense because knowledge

beyond that disclosed in Kramer et al. and Martin Jr. et al. is required to equate the proposed combination and the claimed features. For example, Kramer et al. disclose monitoring only transactions, while Martin Jr. et al. disclose using time and location data of a mobile device only for targeted advertising. It is the Examiner who determines that the disparate teachings can be combined to arrive at the claimed subject matter.

Moreover, claim 6 recites that (emphasis added) "...said at least one monitor monitors the at least one mobile communications device,...and wherein at least one actual user characteristic is varied in accordance with at least one output of said at least one monitor." The Examiner (Examiner's Answer to Appeal Brief of January 28, 2009 at page 44) asserts that (emphasis added) "Kramer/Martin...would thus vary the stored customer characteristics according to the customer's online actions."

Varying customer characteristics in accordance with a customer's online actions is not equivalent to, and does not suggest, varying an actual user characteristic in accordance with an output of a monitor that monitors the mobile communications device. To the contrary, the monitor of claim 6 detects the current time and location of the mobile communications device (see Claim 1), not "online actions." As discussed in the Appeal Brief filed October 30, 2008, updating a consumer model based on transactions at a store is not equivalent to, and does not suggest, varying an actual user characteristic in accordance with output of a monitor – *i.e.*, current time and location – that monitors a mobile communications device. Accordingly, the Examiner also has failed to address the claimed subject matter.

For at least these reasons, claim 6 also is allowable over the proposed combination of Kramer et al. and Martin Jr. et al. based on its own merits. Claims 8-11 depend from claim 6 and therefore also are allowable for at least the reasons discussed with respect to claim 6.

For at least the reasons provided above and in the Appeal Brief file on October 30, 2008, claims 1, 2, 4, 6, 8-12, 14-53, 55-59, 61-64, 66-81, 83-85, 87-101, and 103-105 are patentable over the proposed combinations of Kramer et al. in view of Martin Jr. et al., and Kramer et al. and Martin Jr. et al. in view of Shoham. Therefore, the final rejection should be reversed.

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Respectfully submitted,

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